REMARKS

The Examiner is respectfully thanked for the thoughtful consideration provided to this application. Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 1, 3, 4, 13, and 14 has been amended for reasons unrelated to patentability, including at least one of: to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 1-12 are now pending in this application. Claims 13-21 have been withdrawn. Claims 1, 13, and 14 are in independent form.

The Obviousness Rejections

Each of claims 1-12 was rejected under 35 U.S.C. 103(a) as being unpatentable over various combinations of Martin (U.S. Patent No. 6,866,288), Brim (U.S. Patent No. 5,022,420), Gillins (U.S. Patent No. 5,967,601), Sansing (U.S. Patent No. 4,948,197), Liu (U.S. Patent No. 5,586,810), Howard (U.S. Patent No. 4,030,781), Shields (U.S. Patent No. 4,470,630), and/or Okada (Japanese Patent No. 2001327541). These rejections are respectfully traversed.

None of the references relied upon in the Office Action, either alone or in any combination, establish a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or

motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." *See* MPEP 2143. Moreover, the USPTO "has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967).

If a proposed combination would render a reference inoperable for its intended purpose, the reference teaches away from the proposed combination. *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir. 1994). "If references taken in combination would produce a 'seemingly inoperative device,'... such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness". *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 60 USPQ2d 1001, 1010 (Fed. Cir. 2001).

To the extent that official notice is taken to support any rejection, Applicant respectfully traverses and requests citation and provision of a reference that supports the rejection. ***See*** MPEP 2144.03.

As an initial matter, claims 1-12, and withdrawn claims 13-21, recite, yet none of the applied references teach or suggest, either explicitly or inherently, "a substantially **rigid** horizontal member" "adapted to substantially span" (or "substantially **spanning**") "a width defined by **the pair of uprights** and" "to substantially span" (or "substantially spanning") **above handles** of the **wheelchair**", the "horizontal member comprising a substantially **horizontally extending** and substantially **rigid** lateral **head support** that is **integral** to said horizontal member".

Thus, even if there were motivation or suggestion to modify or combine the references relied upon in the Office Action (an assumption with which the applicant disagrees), and even if

there were a reasonable expectation of success in combining or modify the references relied upon in the Office Action (another assumption with which the applicant disagrees), the references relied upon in the Office Action still do not expressly or inherently teach or suggest every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness.

Moreover, there is no motivation or suggestion to modify or combine the references relied upon in the Office Action, and even if there were, the modification or combination would be inoperative.

In particular, the first primary reference, Martin, alleges that its invention is a "[c]onvertible wheelchair and separate lift module for connecting to and elevating the wheelchair". Title. Thus, Martin allegedly describes a "[w]heelchair 12 [that] is adapted to convert from a conventional chair configuration (FIG. 2) to an examination chair or table." Col. 2, lines 41-43. To accomplish this objective, Martin recites that "the wheelchair 12 is designed and adapted to be connected to the lift module 14. To accommodate this, the wheelchair 12 is provided with a number of connecting links or connecting points." Col. 3, lines 53-56. "Back rest connecting link 37 is also of a generally triangular configuration and is pivotally connected to cross member 26a of the back rest 26." Col. 3, lines 64-66.

Martin states that "back rest 26 is adapted to receive a removable head rest 28. The removable head rest 28 includes a pair of terminal ends that are designed to be inserted within sleeves 26b mounted to the upper portion of the back rest 26." Col. 3, lines 39-43. Because Martin's "wheelchair can be converted from a chair configuration to any one of several examination configurations" (see Abstract), Martin's use of "sleeves 26b" is intentional.

In describing its "process of converting the wheelchair to a table" (col. 5, line 65), Martin states "[i]n preparation for adjusting backrest 26 in a similar fashion, headrest 28 is removed from backrest 26, rotated 180 degrees about the vertical, and reattached to backrest 26" (col. 6, lines 9-12). This process is illustrated in Martin's FIG. 1. Note from the upper dashed orientation to

the lower dashed orientation how "removable head rest 28" has been "rotated about the vertical, and reattached to backrest 26".

The Office Action asserts that "[i]t would have been obvious to one having ordinary skill in the pertinent art at the time of the instant invention to modify the primary reference [Martin] in view of the teachings of any of the secondary references by adding the snap means to the ends of the headrest assembly." Yet on close examination of Martin, this assertion proves unsupported.

If one of ordinary skill in the art were to add "snap means" to the "terminal ends that are designed to be inserted within sleeves 26b" of Martin's "removable head rest 28", one of ordinary skill could no longer insert those "terminal ends" "within sleeves 26b".

If one of ordinary skill were to add snap means to the "terminal ends that are designed to be inserted within sleeves 26b", remove "sleeves 26b", and attempt to connect the added snap means to "the upper portion of the back rest 26", one of ordinary skill would not be able to perform Martin's desired "process of converting the wheelchair to a table" in which "headrest 28 is removed from backrest 26, rotated 180 degrees about the vertical, and reattached to backrest 26". Note that "sleeves 26b" are located behind "the upper portion of the back rest 26" (see FIGS. 3 and 6) to accommodate the placement of "cross member 26a of the back rest 26". Attempting to combine any of the applied references with Martin to arrive at a "snap means" that allows "a headrest assembly" "to non-destructively snapably attach to a pair of uprights of" Martin's wheelchair would also require removing "cross member 26a of the back rest 26" to allow the "snap means" rotated 180 degrees about the vertical, and reattached to backrest 26." Yet this removal of "cross member 26a" renders the combination **inoperative** for Martin's intended purpose of supporting "back rest connecting link 37" which is needed for "wheelchair 12" "to be connected to the lift module 14".

Similarly, the asserted modification and/or combination of the second primary reference, Okada, also proves inoperative. If one of ordinary skill in the art were to add "snap means" to

Okada, one of ordinary skill could not insert "pipe 3", and particularly uprights 322, into "pipe body 42". Moreover, there would be no motivation for one of ordinary skill to replace attachments 43 with "snap means", since Okada already has screw 422 to allow for adjusting the height of "pillow part 2".

Thus, there is no motivation or suggestion to modify or combine the references relied upon in the Office Action, and there is no reasonable expectation of success in combining or modify the references relied upon in the Office Action. Consequently, the Office Action fails to establish a *prima facie* case of obviousness. Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted.

Applicant respectfully notes that because the Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the reference relied upon in the Office Action will necessarily be factually based on an entirely different portion of that reference, and thus will be legally defined as a "new grounds of rejection." Consequently, any Office Action containing such rejection can not properly be made final. *See In re Wiechert*, 152 U.S.P.Q. 247, 251-52 (C.C.P.A. 1967) (defining "new ground of rejection" and requiring that "when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference"), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967) (the USPTO "has the initial duty of supplying the factual basis for its rejection").

Consequently, reconsideration and withdrawal of these rejections is respectfully requested.

Allowable Subject Matter

The following is a statement of reasons for the indication of allowable subject matter:

none of the references of record alone or in combination disclose or suggest the combination of limitations found in the claims. Namely, claims 1-21 are allowable because none of the references of record alone or in combination disclose or suggest "a substantially rigid horizontal member" "adapted to substantially span" (or "substantially spanning") "a width defined by the pair of uprights and" "to substantially span" (or "substantially spanning") above handles of the wheelchair", the "horizontal member comprising a substantially horizontally extending and substantially rigid lateral head support that is integral to said horizontal member".

PATENT

Application # 10/824,533

Attorney Docket # 1059-003

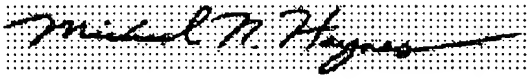
CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

Michael Haynes PLC



Date: 2 September 2005

Michael N. Haynes
Registration No. 40,014

1341 Huntersfield Close
Keswick, VA 22947
Telephone: 434-972-9988
Facsimile: 815-550-8850